

REMARKS

Claims 88 and 93 are canceled without prejudice, and therefore claims 86, 87, 89 to 92, and 94 to 116 are now pending and being considered (since claims 72 to 85 were previously withdrawn in response to a restriction requirement).

Applicants respectfully request reconsideration of the present application in view of this response.

It is respectfully requested that the Substitute Specification be approved and entered.

With respect to paragraph three (3), claims 88 and 93 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

As to the indefiniteness rejections under 35 U.S.C. 112, claims 86 and 91 as presented include the features of claims 88 and 93, respectively, which have been canceled without prejudice. In claim 86 (and 91), as presented, the sending step includes sending a third party certificate to the second apparatus, the third party certificate being a certificate representing that the first apparatus is authenticated by a third party; and the second apparatus authenticates the first apparatus by verifying that the third party certificate authenticates the first apparatus and that a certifier of the third party certificate is included in third parties stored in the second apparatus. Accordingly, claims 86 and 91 as presented clearly recite that the certificate authenticates the first apparatus. It is therefore respectfully requested that the indefiniteness rejections be withdrawn.

With respect to paragraph seven (7), claims 86, 90, 91, 95, 96, 98-104, 108, 109 and 111-116 were rejected under 35 U.S.C. § 102(b) as anticipated by Menezes in Handbook of Applied Cryptography.

With respect to paragraph nine (9), claims 86, 87, 91, 92, 96, 97-109 and 110 were rejected under 35 U.S.C. § 102(b) as anticipated by Caronni et al., U.S. Patent No. 5,822,434.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the anticipation rejections may not be agreed with, to facilitate matters, claims 86, 91, 96, 100, 102, 104, 105, and 109 now include further features which are simply not identically described or even suggested by the references relied upon. Claims 87, 92, 97-99, 1011, 103, 106 to 108 are dependent claims of claims 86, 91, 96, 100, 102, 104, 105 and/or 109 and are therefore allowable for the same reasons as the independent claims.

In particular, it is believed and respectfully submitted that any review of the applied references makes plain that the “Menezes” and “Caronni” references do not identically describe (or even suggests) the feature in which “the second apparatus authenticates the first apparatus by verifying that the third party certificate authenticates the first apparatus and that a certifier of the third party certificate is included in third parties stored in the second apparatus” in the original data circulation method, as provided for in the context of claim 86 (and the other independent claims having this feature). The “Menezes” reference may refer to public-key certificates, but it does not identically describe (or even suggest) the above feature in the original data circulation method. Further, neither the “Menezes” nor the “Caronni” references identically describes (or even suggest) the feature in which “accredited information” and “the accredited information and the originality information are sent” as provided for in the context of claim 96 (and the other independent claims having this feature) as presented.

Accordingly, claims 86, 90, 91, 95, 96, 98 to 104, 108, 109 and 11 to 116, as presented, are allowable.

With respect to paragraph eight (8), claims 87-89, 93, 94, 97, 105-107 and 110 were rejected as unpatentable under 35 U.S.C. § 103(a) over the “Menezes” reference.

Claims 88 and 93 were canceled without prejudice in view of the rewriting of the independent claims, as explained above. As to the remaining claims, these claims depend from claims 86 or the other independent claims, and are therefore allowable for essentially the same reasons as explained above.

It is therefore respectfully requested that the obviousness rejections be withdrawn.

In summary, it is respectfully submitted that all of claims 86, 87, 89 to 92, and 94 to 116 of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 86, 87, 89 to 92, and 94 to 116 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,
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